

REMARKS

After entry of the subject amendment, claims 1-15 and 17-47 remain in the application with claims 1, 6, and 30 in independent form. More specifically, claims 1, 6, and 17 have been amended, claim 16 has been canceled, and claim 47 has been added in this amendment. There is full support in the specification for the amendments to claims 1, 6, and 17 and for added claim 47. Accordingly, no new matter has been added.

The specification has been amended to correct minor grammatical and typographical errors.

Claims 1-46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bassett (United States Patent No. 4,139,514). The Applicants respectfully traverse.

The Clearcoat Composition Claims:

Independent claims 1 and 6 have been amended to require that the water-soluble surfactant be present in the clearcoat composition in an amount from 0.1 to 5 parts by weight based on 100 parts by weight of the clearcoat composition. In the original specification, 0.1 is described as the most preferred lower amount of water-soluble surfactant and 5 is described as the preferred upper amount of water-soluble surfactant. The specification further describes that, no matter what particular water-soluble surfactant, these amounts are ideal for reducing ability of rain to bead on a film of the clearcoat composition.

In contrast, although Bassett discloses a clearcoat composition that contains dioctyl sodium sulfosuccinate as a surfactant, Bassett does not disclose, teach, or otherwise suggest such amounts of the water-soluble surfactant being present in the clearcoat composition. Instead, in Bassett, the dioctyl sodium sulfosuccinate is first incorporated into a waterborne latex resin and not directly into the clearcoat composition. The latex resin is subsequently incorporated into a paint. It is this paint of Bassett that is comparative to the clearcoat composition claimed in the present application.

Example 26 of Bassett (see column 9, line 27) particularly illustrates the minute amount dioctyl sodium sulfosuccinate that is present in the final paint composition of Bassett. Ex. 26 has the following components:

Paint	
Water-soluble vehicle, Ex. 26	1370
Pigment paste	740.2
Dimethylethanolamine	52
Hexamethoxymethylmelamine	96.4
Water	950
Foamaster VL (Defoamer)	1.5
Total	3210.1

The water-soluble vehicle of Ex. 26 is present in the paint in an amount of 1370 parts. This vehicle was prepared according to Example 14 as outlined below:

Water-soluble vehicle		
Component	Pts.	%
Water	800	88.30
Diethyl sodium sulfosuccinate	1.5	.17
Ammonium persulfate	3.5	.39
Styrene	30	3.31
Ethyl acrylate	45	4.97
2-Hydroxyethyl acrylate	12.5	1.38
Methacrylic acid	12.5	1.38
Butyl mercaptan	1.0	.11
Total	906.0	100.0

Therefore, only 2.33 parts ($.17/100 = .0017 \times 1370 = 2.33$ parts) of the 1370 parts of the water-soluble vehicle in the paint of Ex. 26 is dioctyl sodium sulfosuccinate and 2.33 divided by the total amount of paint 3210.1 gives .073 parts of dioctyl sodium sulfosuccinate based on 100 parts by weight of the paint (or .073%).

This calculation illustrates the highest amount of dioctyl sodium sulfosuccinate that the paint of Bassett would contain because the calculation even ignores the fact the water-soluble vehicle of Example 14 was "solubilized" by the addition of a 50 weight percent aqueous solution of dimethylethanolamine (DMEA) to a pH of between 8 and 9 (see column 6, lines 60-67). The addition of this aqueous solution of DMEA would

further reduce the relative concentration of dioctyl sodium sulfosuccinate. Thus, the amount of dioctyl sodium sulfosuccinate would be even lower.

In conjunction with the amendments to the claims and with the reasoning set forth above, it is respectfully submitted that Bassett does not anticipate independent claims 1 and 6, as amended, and any rejection under § 102(b) cannot be sustained.

Furthermore, it is respectfully submitted that no *prima facie* case of obviousness relying on Bassett could reasonably be established against independent claims 1 and 6 such that any § 103(a) rejection of these claims would be unfounded. This is true for several reasons. First, Bassett does not teach or suggest all of the limitations of the amended independent claims, specifically the amount of the water-soluble surfactant. Secondly, in all instances, Bassett incorporates the same amount of dioctyl sodium sulfosuccinate into the resin and not directly into the paint, i.e., the clearcoat composition. As a result, there is no motivation to modify Bassett (or to combine it with any other references of record) to increase the amount of dioctyl sodium sulfosuccinate in the paint to the higher amounts that are claimed in amended independent claims 1 and 6, and the recently-decided case of *In re Sang Su Lee* requires that the prior art provide such a motivation without the Examiner relying on subjective belief when making an argument to modify a reference or motivation to combine references. Thirdly, it is even arguable that Bassett is non-analogous art. Every single paint composition of Bassett, without exception, incorporates titanium dioxide. Therefore, the paint compositions of Bassett, which as described above are comparative to the clearcoat composition of the present application, are not clearcoat compositions whatsoever. Instead, the paint compositions of Bassett are pigmented and merely incorporate a resin, the water-soluble vehicle (or waterborne latex resin) that happens to be clear.

The Method Claims:

The method of independent claim 30 requires that a resin of the clearcoat composition be provided and that a cross-linking agent of the clearcoat composition be incorporated with the resin to first form an intermediate composition. Once this intermediate composition is formed, the method then requires that the water-soluble

surfactant be incorporated into the intermediate composition to form the clearcoat composition. That is, the water-soluble surfactant is added to the intermediate composition that already includes the resin and the cross-linking agent. The water-soluble surfactant is not added to the resin during a separate process for producing the resin. As described throughout the original specification, the significance of this method is that it reduces the ability of rain to bead on a film of a clearcoat composition, which improves resistance to etch from acid rain.

As alluded to above, Bassett does not form a clearcoat composition, i.e., a composition that is clear, at all. Instead, all of the paint compositions are pigmented and only the resin is clear, which is typical for a resin. Ignoring this fact for argument's sake, Bassett does not disclose, teach, or suggest the step of incorporating the water-soluble surfactant into an intermediate composition that already includes a resin and a cross-linking agent. Instead, Bassett merely discloses the incorporation of a water-soluble surfactant into a resin. Simply stated, Bassett does not disclose, teach, or suggest the post-adding of a water-soluble surfactant to an intermediate composition of a final clearcoat composition once the intermediate composition has already been formed. As a result, Bassett does not anticipate independent claim 30 and any rejection under § 102(b) cannot be sustained.

Also, Bassett does not render the method invention, as claimed in independent claim 30, obvious. In short, due to the same § 103(a) reasoning outlined above, Bassett does not provide any motivation, either alone or in combination, to post-add a water-soluble surfactant to an intermediate composition, that is defined to already include a resin and a cross-linking agent, to form a clearcoat composition.

As a result of the amendments to the claims and in view of the remarks set forth above, it is respectfully submitted that independent claims 1 and 6, as amended, and independent claim 30 are allowable. Furthermore, the remaining claims, specifically dependent claims 2-5, 7-15, 17-29, and 31-47, depend from these independent claims such that these claims are also allowable.


It is respectfully submitted that the application is now presented in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

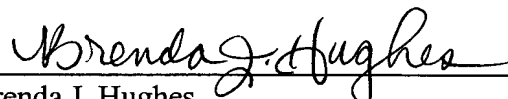
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CERTIFICATE OF MAILING

I hereby certify that the attached **Amendment** is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to **Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, on **October 3, 2003**.


Brenda J. Hughes

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